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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,188	02/04/2002	John Walter Liebeschuetz	00217/US	8359

24330 7590 08/12/2003

Martin A. Hay
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UNITED KINGDOM

EXAMINER

PATEL, SUDHAKER B

ART UNIT PAPER NUMBER

1624

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,188

Applicant(s)

LIEBESCHUETZ ET AL.

Examiner

Sudhaker B. Patel, D.Sc.Tech.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-31 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 5.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) (in part) 1-18,21-26,29,32-35, drawn to compounds, composition, and a method of treatment for Formula (I) wherein Y = CR1b; Cy = Aryl or phenyl or naphthyl..

Group II, claim(s) (in part) 1-18,21-26,29,32-35, drawn to compounds, composition, and a method of treatment for Formula (I) wherein Y = CR1b; Cy = Pyridine or piperidine..

Group III, claim(s) (in part) 1-18,21-26,29,32-35, drawn to compounds, composition, and a method of treatment for Formula (I) wherein Y = CR1b; Cy = Thiazolyl, Oxazolyl,pyrazolyl,imidazolyl,pyrrolinyl,thiadizolyl.

Group IV, claim(s) (in part) 1-18,21-26,29,32-35, drawn to compounds, composition, and a method of treatment for Formula (I) wherein Y = CR1b; Cy = Thienyl, furanyl..

Group V, claim(s) (in part) 1-18,21-26,29,32-35, drawn to compounds, composition, and a method of treatment for Formula (I) wherein Y = CR1b Cy = Pyrimidinyl.

Group VI, claim(s) (in part) 1-18,21-26,29,32-35, drawn to compounds not included in above Groups I-V.

2. The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: They form different chemical structures which are not art recognized equivalents. The common bridge, -X-X-CH or NH-L- is not a patentable bridge,

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3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

The variations in components Y, Cy together with R1, X, L, Lap (D) will provide multiples of species.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

4. The claims are deemed to correspond to the species listed above in the following manner:

- When Cy is aryl = non heterocycle.
- When Cy is pyridine or its hydrogenated form is a 6-membered heterocycle.
- When Cy is 5-membered ring with a N and other heteroatoms.
- When Cy is a ring without N, but has Oxygen or S only as heteroatoms(s).
- When Cy is a 6-membered heterocycle with 2 N.

The following claim(s) are generic: Claims 1,23,29,31,32,34,35.

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5. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The common technical feature is a bridge: -X-X-CH or NH-L which is not a patentable group.

6. Examiner tried to make a telephone call to Mr. Hay on 8/5/03 to request an oral election to the above restriction requirement, but as applicants' Offices are overseas, examiner could not reach them, therefore the call did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. Applicants' attention is also drawn to fact that the certified papers for the priority has not been received in the file received by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhaker B. Patel, D.Sc.Tech. whose telephone number is 703 308 4709.

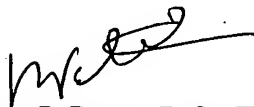
The examiner can normally be reached on 6:30 to 5:00 pm. Monday-Thursday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's


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supervisor, Dr. Mukund J. Shah can be reached on 703 308 4716 or Sr. Examiner Mr. Richard Raymond at 703 308 4523.

The fax phone numbers for the organization where this application or proceeding is assigned are 703 308 4556 for regular communications and 703 308 4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1235.


Sudhaker B. Patel, D.Sc.Tech.
August 4, 2003.


MUKUND SHAH
SUPERVISORY PATENT
EXAMINER
ART UNIT 1624